REMARKS

The Office Action mailed October 12, 2004 has been received and carefully considered. Claims 1-20 are currently pending. Claim 10 is objected to. Claims 1-20 stand rejected. Claims 1, 9 and 16 stand rejected under 35 U.S.C. §112, 2nd paragraph as assertedly indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-2, 7-11, 14-16 and 18-20 stand rejected under 35 U.S.C. § 102(b) as assertedly anticipated by Towers' Dreamweaver 2 for Windows and Macintosh, 1999, Peachpit Press (Towers). Claims 3-4, 6 and 12 stand rejected under 35 U.S.C. § 103(a) as assertedly obvious over Towers in view of U.S. Patent 5,758,093 to Boezeman et al. (Boezeman). Claims 5, 13 and 17 stand rejected as assertedly obvious over Towers in view of Boezeman and further in view of U.S. Patent 4,713,754 to Agarwal et al. (Agarwal).

I. Amendments to the claims.

Claim 10 has been amended. The amendment is fully supported by the specification as originally filed and presents no new matter.

II. Objection to claim 10.

The Examiner has objected to claim 10 ostensibly on the ground of a clerical error that resulted in an alleged informality. Claim 10, as filed, did not contain the clerical error suggested by the Examiner, but did include the abbreviated phraseology "to customize said selected field." Applicants respectfully submit that when read in the context of claim 10, those of ordinary skill in the art would readily appreciate this language to refer to the antecedent "to customize a visual appearance and dynamic behavior of said selected field." Nevertheless, to advance the prosecution of the case, Applicants have amended claim 10 to avoid the abbreviated phraseology in a manner believed to overcome the objection.

III. **Rejection under 35 U.S.C. §112, 2nd paragraph.**

Claims 1, 9, and 16 stand rejected under 35 U.S.C. §112, 2nd paragraph. Applicants respectfully traverse the rejection. The Examiner has stated that it is unclear whether Applicants intend to claim that the method/system/program of claims 1, 9 and 16 respectively are executable by a web browser, or whether the web page/web application/input form (again referring to claims 1, 9 and 16 respectively) are executable by a web browser.

A claim is definite if it reasonably apprises one of ordinary skill in the art of the scope of the claimed invention. *See SmithKline Beecham Corp. v. Apotex Corp.*, 70 USPQ2d 1737, 1743 (Fed. Cir. 2004). *See also*, MPEP 2173.02. Applicants respectfully submit that the preamble of each of claims 1, 9 and 16 (which serves as the basis for the Examiner's rejection) is clear and definite so as to apprise one of ordinary skill in the art of the subject matter being claimed, especially when the entire claim is read as a whole. In each of the three rejected claims, the phrase "executable by a web browser" follows, without punctuation, the noun that it modifies, i.e. web page, web application, and input form; no amendment is necessary to further clarify this point. Were a different meaning intended, then the phrase "executable by a web browser" would be properly offset by commas, indicating an intent to modify the subject, i.e. method, system and computer program, which punctuation is not present in independent claims 1, 9 and 16.

As one of ordinary skill in the art reading the claims would immediately be reasonably apprised of the scope of Applicants' claimed invention, the rejection under 35 U.S.C. §112, 2nd paragraph should be withdrawn.

IV. **Rejection under 35 U.S.C. § 102(b).**

Claims 1-2, 7-11, 14-16 and 18-20 stand rejected as assertedly anticipated by Towers. Applicants respectfully traverse the rejection.

It is well established that to anticipate an invention, a reference must teach each and every element of the claimed invention, either explicitly or inherently. *In re Schreiber*, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It is also well established that the prior art reference must be enabling, thus placing the allegedly disclosed subject matter in the possession of the public. *Akzo N.V. v. U.S. International Trade Commission*, 1 USPQ2d 1241, (Fed. Cir. 1986). *See also* MPEP 2121.

In making the rejection under Towers, the Examiner has failed to cite an enabling reference as the portions of Towers provided to Applicants provide an insufficient amount of information to make and use the invention that the Examiner asserts has been disclosed. Even if Towers was enabling, which Applicants submit it is not, Towers still fails to disclose each and every element of Applicants' claimed invention.

A. Towers is not an enabling reference.

Towers is a reference guide that is at least 355 pages long (based on the highest numbered page cited by the Examiner). Yet, in making the rejection, the Examiner has only provided Applicants 15 non-consecutive pages – 2 of which include the cover and inside cover – selecting only those that purport to support the Examiner's position. One of ordinary skill in the art consulting only these pages would not appreciate the reference to enable Applicants' claimed invention, particularly since there is no evidence that the limited information found on these non-consecutive pages all interrelate in the same way as Applicants' claimed invention.

Further, those few pages that are provided are incomplete. For example, the Examiner relies on page 233 of Towers in rejecting each of the independent claims. Yet, page 233 begins at step 3 of a process that is at least 7 steps. No preceding or following pages have been provided to Applicants to aid in the context of what Towers is actually teaching. For example, of

the steps numbered 3-7 that are listed on page 233, step 3 refers to a Figure that has been only partly reproduced. Steps 4, 5, and 7 each direct a reader elsewhere in the text for a definition of a term or explanation of a process, although none of these pages nor their contents have been provided to Applicants.

Thus, one of ordinary skill in the art consulting those portions of Towers which the Examiner has cited would not be enabled to make and use anything, much less arrive at Applicants' claimed invention. As Towers is not enabling, it may not be used as a reference under 35 U.S.C. §102(b) to reject the Application and the rejection should be withdrawn.

B. If Towers is enabling, it still fails to anticipate the claimed invention.

Although only limited sections of Towers have been provided to Applicants, Towers is believed to be directed to assisting users create web pages using a software product entitled Dreamweaver.

Independent claim 1 is directed to method for developing a web page executable by a web browser, while independent claims 9 and 16 are directed to a system to develop and provide a web application executable by a web browser and a computer program product embodied on a computer readable medium and executable by a computer for developing an input form executable by a web browser, respectively.

Specifically, the method found in claim 1 comprises opening a visual development environment, wherein the visual development environment includes a visual representation of the web page under development; selecting a field from a plurality of field types to be included in the web page; inserting the selected field into the visual development environment; customizing a visual appearance of the inserted field using a visual editor of the visual development environment; customizing dynamic behavior of the inserted field using at least one additional

visual editor of the visual development environment; repeating the steps of selecting a field, inserting the selected field, customizing a visual appearance of the inserted field, and customizing dynamic behavior of the inserted field until all fields are included in the web page; and generating, in a single file, program code executable by a web browser to implement the visual appearance and dynamic behavior of the selected fields inserted into the visual development environment.

The system of claim 9 comprises a computer, said computer comprising a storage device and a processor; an authoring tool, said authoring tool being stored on said computer, said authoring tool being configured for use by an author to generate a web application, said authoring tool comprising a visual development environment to generate a visual appearance and dynamic behavior for fields of said web application and a code generator to generate program code for said web application to implement said generated visual appearance and dynamic behavior of said fields of said web application in a single file executable by a web browser; and at least one server communicating with said authoring tool, said at least one server comprising means for providing access to said generated program code for said web application to an end-user having a web browser.

The computer program of claim 16 executes the steps of providing a visual development environment, wherein the visual development environment includes a visual display of an input form representing a current state of the input form; selecting an input field from a plurality of input field types; customizing a visual appearance of the selected input field using a visual editor of the visual development environment; customizing dynamic behavior of the selected input field using at least one additional visual editor of the visual development environment; incorporating the customized selected input field into the visual display of the input form in the visual

development environment; repeating the steps of selecting an input field, customizing a visual appearance of the selected input field, customizing dynamic behavior of the selected field, and incorporating the customized selected input field until all input fields are included in the input form; and generating, in a single file, program code for the input form executable by a web browser to implement the visual appearance and dynamic behavior of the selected input fields of the input form.

Each of independent claims 1, 9 and 16, and thus all claims depending therefrom, includes the limitation that program code is generated as a single file for execution by the web browser. While the Examiner cites page 18 of Towers for purporting to teach this limitation of Applicants' claimed invention, page 18 teaches only that a web page created with the Dreamweaver program discussed in Towers can be saved as an "html" file. Towers does not explicitly or inherently teach, disclose or suggest that the saved html file is a single file created for execution by a web browser that generates both a visual appearance and a dynamic behavior of certain fields, e.g. without plug-ins, modifications or add-ons.

Furthermore, in claims 1 and 16, Applicants' claimed invention requires customizing dynamic behavior of a field using at least one additional visual editor of the visual development environment. The excerpts from Towers cited by the Examiner with respect to behavior modification, pages 229 and 233, make no reference that the behavior modification is a dynamic customization nor whether the behavior modification is taking place in the visual development environment.

Applicants' claimed invention also requires repeating certain steps until all fields are included in the web page (claim 1) or input form (claim 16). The Examiner cites an excerpt from Towers at page 141 as allegedly disclosing this element, in which Towers shows a Figure of a

completed form assertedly made by Towers' disclosed process. Not only does the page 141 provided to Applicants fail to show the entire Figure, the accompanying textual description contains nothing to indicate that the forms shown in the Figure resulted from any particular process, much less that it included customizing dynamic behavior of any fields. In fact, such an inclusion would be somewhat remarkable since the portion of Towers that the Examiner has asserted teaches dynamic behavior comes one hundred pages later. The Examiner has merely asserted that because the form appears in Towers, it necessarily evidences a repetition of certain steps of Applicants' claimed invention. However, the Examiner has failed to show that Towers contains various steps of Applicants' claimed invention, much less that those steps are repeated.

With respect to claim 9, at most Towers only teaches a remote site to which one can connect to an existing web site. There is no teaching in Towers that a server provides access to generated program code for a web application to an end-user having a web browser.

Thus, as Towers fails to teach or suggest each and every limitation of Applicants' claimed invention as recited in independent claims 1, 9 and 16, it cannot anticipate the invention and the rejection should be withdrawn. Dependent claims 2, 7-8, 10-11, 14-15, 16 and 18-20, all of which were also rejected under 35 U.S.C. §102(b), are believed to be allowable as depending from what are believed to be allowable independent claims 1, 9 and 16 for the reasons given above.

V. **Rejections under 35 U.S.C. § 103(a).**

Claims 3-4, 6 and 12 stand rejected as assertedly obvious over Towers in view of Boezeman. Claims 5, 13 and 17 stand rejected as assertedly obvious over Towers in view of Boezeman and further in view of Agarwal. Boezeman is directed to a method and apparatus for generating a unique event for a particular part at a particular time for a multi-media title and is

cited by the Examiner only as an alleged example of using a graphical editor to control error conditions. *See* Office Action at page 7. Agarwal is directed to a data structure in a document processing system where each page of a document is subdivided into non-overlapping areas. Agarwal is cited by the Examiner only for the proposition that certain fields used within a computer program can be interrelated. *See* Office Action at page 8. Applicants respectfully traverse the rejection.

Each of claims 3-6, 12-13 and 17 depends from one of claims 1, 9 or 16, which are believed allowable for the reasons provided above. Furthermore, neither Boezeman nor Agarwal, individually or in combination, overcome the deficiencies of Towers. Thus, for at least the reasons set forth above, claims 3-6, 12-13 and 17 are also allowable and the rejections under 35 U.S.C. §103(a) should be withdrawn.

CONCLUSION

For at least the reasons above, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. Applicants respectfully submit that claims 1-20 are not anticipated by Towers, nor rendered obvious by Towers in view Boezeman and/or Agarwal, and thus, are in condition for allowance. As the claims are not anticipated by, nor rendered obvious in view of, the applied art, Applicants request allowance of claims 1-20 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

This Response has been filed within three months of the mailing date of the Office Action and it is believed that no additional fees are due with the filing of this Response. The Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: January 3, 2005

Respectfully submitted,

MCNEES WALLACE & NURICK LLC
Attorneys for Applicants

By: 

Shawn K. Leppo, Reg. No. 50,311
P.O. Box 1166
100 Pine Street
Harrisburg, Pennsylvania 17108
Direct Dial: (717) 237-5218
Facsimile: (717) 237-5300

PTO/SB/97 (08-03)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on January 3, 2005.
Date

Kimberly A Newell
Signature

Kimberly A. Newell
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Transmittal Form
Response Under 37 C.F.R. 1.111 (18 pages)
Certificate of Fax Transmittal

Attorney Docket No.: RD-28615 (07783-0073)
Application No.: 09/917,435 Filed: July 27, 2001